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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/630,407	08/01/2000	Takanobu Noguchi	Q60265	5925

7590 04/28/2003

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EXAMINER

YAMNITZKY, MARIE ROSE

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 04/28/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/630,407

Applicant(s)

NOGUCHI ET AL.

Examiner

Marie R. Yamnitzky

Art Unit

1774

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 April 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 14 April 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: None.

Claim(s) objected to: None.

Claim(s) rejected: 1-14.

Claim(s) withdrawn from consideration: None.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

MEY
04/28/03

Continuation of 2. NOTE: In proposed amended claim 1, the definitions of the variables in formula (2) are deleted but formula (2) is retained. In proposed amended claims 1 and 2, the added formula (5) is incorrect because it does not include a subscript "j" after the ring containing X5-X7 (compare to formula (5) in original claim 3; the definition of "j" is set forth in proposed amended claims 1 and 2). (If the amendment was resubmitted with the correction of formula (5) in claims 1 and 2, and the deletion of formula (2) from claim 1, the amendment would be entered.)

Continuation of 5. does NOT place the application in condition for allowance because: The examiner maintains the position of record regarding the rejection under 35 U.S.C. 112, first paragraph. Even if the proposed amendment was entered, the examiner would maintain the rejection under 35 U.S.C. 112, first paragraph. Contrary to applicants' comments, polymeric substance 4 as disclosed in the specification is within the scope of proposed amended claim 1. The repeating unit of formula 18 in polymeric substance 4 is a repeating unit of formula (1) wherein n is 0 and Ar1 is a group represented by formula (5), wherein in formula (5), j is 0 and each of X1-X12 represents C-R7 wherein R7 of X3 and X12 represents alkyl groups and the two rings are connected via the substituents R7 of X3 and X12. Further, with respect to applicants' arguments in the paragraph bridging pages 11 and 12 and in the first full paragraph on page 12 of the amendment filed 14 April 2003, presuming polymeric substance 4 as disclosed in the specification meets condition (c) of claim 1, one would not have readily determined that condition (c) was satisfied by using estimates based on the fluorescent peak and absorption edge wavelength of the copolymer. To the contrary, using estimated wavelengths based on the copolymer, one would have determined that polymeric substance 4 did not meet condition (c). Further, applicants' arguments do not address the situation where the copolymer contains more than two different repeating units.



MARIE YAMNITZKY
PRIMARY EXAMINER

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